

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN S. BARKER, JOHN E. DILLER, JAMES L. GAY,
MARGARET M. HEDSTROM, CAROL J. PERSCHE,
MOHAMAD R. SALAHSHOOR, JOHN W. SWEITZER, and JAMES THORPE

Appeal No. 2006-1754
Application No. 10/046,940

ON BRIEF

MAILED

AUG 18 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, KRASS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

REMAND AND ORDER

This is a remand to the examiner of the application containing an appeal under 35 U.S.C. § 134, in accordance with 37 CFR § 41.50(a)(1), and an order to appellants in accordance with 37 CFR § 41.50(d).

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BACKGROUND

The rejection of claims 1-25 has been appealed. Claim 1 is reproduced below.

1. A method of generating display information from management definition data, said method comprising:

receiving an element request from a user;

locating a display name corresponding to the element request in a management definition object;

retrieving one or more qualifier values and one or more data definitions corresponding to the display name, wherein the retrieving includes reading the management definition object;

creating one or more data elements using the data definitions; and

writing the qualifier values and data elements to a display panel.

In the Final Rejection (mailed Jan. 28, 2005), the examiner rejected claims 1-23 and 25 under 35 U.S.C. § 102(e)(1), and claim 24 under 35 U.S.C. § 103(a), over published patent application US 2003/0095145 A1 ("Patrizio"), filed October 30, 2001.

The examiner indicated in the Final Rejection that appellants' declaration filed under 37 CFR § 1.131 is ineffective to antedate Patrizio because: (1) the declaration is signed by less than all the named inventors; (2) the submitted evidence is insufficient to establish conception of the invention prior to the effective date of the reference; (3) the submitted evidence fails to show the claimed invention was reduced to practice prior to the effective date of the reference; and (4) the submitted evidence is insufficient to show conception of the invention prior to the effective date of the reference coupled

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with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

In the Examiner's Answer (mailed Oct. 19, 2005), the examiner did not respond to appellants' arguments in the Brief (filed Jul. 28, 2005) regarding why the 131 declaration should be deemed effective to antedate Patrizio. According to the Answer (at 2), "[t]his issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201."

REASON FOR REMAND

Contrary to the indication in the Answer, review on the merits of a 37 CFR § 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences. MPEP § 715.08 (Eighth Ed., Rev. 4, Oct. 2005) (section identical to Rev. 3, Aug. 2005).

Accordingly, this application is remanded to the examiner for further consideration of a rejection. See 37 CFR § 41.50(a)(1); MPEP § 1211.01. If a supplemental examiner's answer is written in response to this remand, absent entry of a new ground of rejection in said answer, the supplemental answer must be limited to addressing issues relating to the 131 declaration.

ORDER TO APPELLANTS

37 CFR § 41.37(c)(1)(v) requires that a brief contain the following:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” in appellants’ Brief is deficient.

Moreover, the Summary is inconsistent with the remarks in the amendment filed November 1, 2004 that purported to point out support in the disclosure for the material added to the claims by the amendment. For example, the Brief (at 3) contends that “creating data elements using data definitions” is disclosed at Figure 15 element 1575, and specification page 38, line 15 through page 40, line 20. The amendment filed November 1, 2004, however, contends (at 16) that “creating one or more data elements using the data definitions” is disclosed at Figure 9 and specification page 27, line 5 through page 29, line 5.

The instant Brief’s general references to figures and specification sections do not tell us what it is that appellants are claiming. With reference to claim 1 (reproduced supra), the Summary does not clearly demonstrate what an “element” (in an “element request”), a “qualifier value,” a “data definition,” and a “data element” may be, by

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reference to either definition or exemplary embodiment in the specification. Further, although the Summary recognizes that some of the claims (e.g., 15 and 25) are in means plus function format, the *structure, material, or acts described in the specification as corresponding to each claimed function* are not set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

IF a supplemental examiner's answer is written in response to this remand, appellants MUST within two months from the date of the supplemental examiner's answer, to avoid sua sponte dismissal of the appeal as to all the claims, either request that prosecution be reopened before the examiner or request that the appeal be maintained by filing a reply brief as provided in § 41.41. See 37 CFR § 41.50(a)(2).

Due to the deficiency of the instant Brief, IF a reply brief is filed in response to a supplemental examiner's answer, appellants MUST provide a "Summary of claimed subject matter" in the reply brief as a substitute for the Summary in the instant Brief. We do not require, and appellants should not submit, a separate paper to the Board to supplement the instant Brief. However, the claimed subject matter must be addressed as required by 37 CFR § 41.37(c)(1)(v) in any future brief in support of the instant claims.

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CONCLUSION

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This remand includes an order to appellants pursuant to 37 CFR § 41.50(d), contingent upon submission of a reply brief to a supplemental examiner's answer written in response to this remand or submission of any future brief relating to the claimed subject matter of this appeal.

This application, by virtue of its "special" status, requires an immediate action.

See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

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REMANDED -- 37 CFR 41.50(d) ORDER



KENNETH W. HAIRSTON
Administrative Patent Judge



ERROL A. KRASS
Administrative Patent Judge

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) BOARD OF PATENT
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) INTERFERENCES



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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